

C. APPLICANT'S COMMENTS

Claims 1-7, 9, 11-17 are pending in this Application, with Claims 8, 10 canceled, with Claims 1, 5, 6, 7, 9, 11 being amended and Claims 18-22 being added. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Reconsideration of Claims 1-7, 9, 11-17 and favorable consideration of Claims 18-22 is respectfully requested. The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraph 1 of the Office Action

The Official Action rejected as-filed Claims 1, 2, 4-6, 8, 9, 12-16 under 35 U.S.C. §102(b) as being anticipated by Ranken (U.S. Patent No. 2,259,267). The Applicant respectfully disagrees with this rejection for at least the following reasons.

It is important to first briefly discuss 35 U.S.C. §102 and its application to the present application. Under 35 U.S.C. §102(b), anticipation requires that the prior art reference both (1) disclose, either expressly or under the principles of inherency, every limitation of the claim, and (2) be enabling thus placing the allegedly disclosed matter in the possession of the public.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."¹ "The identical invention must be shown in as complete detail as is contained in the ... claim."² Hence, under 35 U.S.C. §102, anticipation requires that each and every element of the claimed invention be disclosed in the prior art.³ Anticipation also requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.⁴ In addition, the prior

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

² *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

³ *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

⁴ *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984).

art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public.⁵

Independent Claim 1 has the following features (Original Claims 1, 8 and 10 combined):

1. (Currently Amended) A sleeping bag system, comprising:
 - a sleeping bag;
 - a ground cloth attached to said sleeping bag;
 - a canopy attached to said ground cloth, wherein said canopy includes a pair of side panels, a top panel and an end panel which are interconnected to each other and said ground cloth with a plurality of zipper fasteners, wherein said end panel has a two-way storage compartment; and
 - support poles attachable to said canopy for supporting said canopy about said sleeping bag.

The Applicant respectfully submits that Ranken does not qualify as appropriate prior art under 35 U.S.C. §102(b) as Ranken does not disclose (expressly or inherently) all of the features of independent Claim 1. Therefore, Applicant respectfully submits that independent Claim 1 is patentable over the cited reference for at least these reasons. Accordingly, Applicant respectfully requests that the Examiner withdraw the outstanding rejection as applied to independent Claim 1, since the application is in condition for allowance.

Paragraph 2 of the Office Action

The Official Action rejected Claims 3, 7, 11, 17 under 35 U.S.C. §103(a) as being unpatentable over Ranken in view of Leibold (U.S. Patent No. 1,670,460) or Strausser (U.S. Patent No. 6,192,909). The Applicant respectfully disagrees with this rejection of these claims for at least the following reasons.

i. Burden on Examiner to Establish Prima Facie Case

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art.⁶ When references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection

⁵ *Akzo N.V. v. United States Int'l Trade Comm'n*, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987) (emphasis added).

⁶ *In re Bell*, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

is improper and will be overturned upon appeal.⁷ “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.”⁸

“To establish a prima facie case of obviousness, three basic criteria must be met.”⁹ First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.¹⁰

ii. Legal Requirements for Obviousness

“Precedent requires that to find a combination obvious there must be some teaching, suggestion, or motivation in the prior art to select the teachings of separate references and combine them to produce the claimed combination.”¹¹ “An explicit teaching that identifies and selects elements from different sources and states that they should be combined in the same way

⁷ *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

⁸ *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

⁹ MPEP §706.02(j).

¹⁰ *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

¹¹ *In re Johnston*, 435 F.3d 1381, 2006 WL 213719 (Fed. Cir. 2006) (citing *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1385 (Fed. Cir. 2001) (“In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.”); *In re Dance*, 160 F.3d 1339, 1343 (Fed.Cir.1998) (“When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention.”); *In re Fine*, 837 F.2d 1071, 1075 (Fed.Cir.1988) (there must be “some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed.Cir.1985) (“When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.”).

as in the invention at issue, is rarely found in the prior art.”¹² “As precedent illustrates, many factors are relevant to the motivation-to-combine aspect of the obviousness inquiry, such as the **field of the specific invention**, the **subject matter of the references**, the extent to which they are **in the same or related fields of technology**, the **nature of the advance** made by the applicant, and the **maturity and congestion of the field**.”¹³ Obviousness requires proof “that the skilled artisan ... would select the elements from the cited prior art references for combination in the manner claimed.”¹⁴

It is further submitted that combining elements from different prior art references must be motivated or suggested by the prior art.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious -- there must be a motivation provided by the prior art.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person*." Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law

¹² *Id.*

¹³ *Id.*

¹⁴ *In re Rouffet*, 149 F.3d 1350, 1358 (Fed.Cir.1998).

which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

iii. Analysis

First, there is **no suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there is **no reasonable expectation of success** of combining the references. Finally, the prior art references when combined do **not teach or suggest all the claim limitations**.

For these reasons, among others, the combination of the references cannot suggest the combination of features in applicant's claims, particularly as the same are now amended, and it is therefore submitted that the rejection against these claims should be withdrawn and Claims 1-7, 9, 11-22 allowed.

Added Claims 18-22

The Applicant has added independent Claim 18 which has the following features:

18. (New) A sleeping bag system, comprising:
a sleeping bag;
a ground cloth attached to said sleeping bag;
a canopy attached to said ground cloth, wherein said canopy includes a pair of side panels, a top panel and an end panel;
a first support pole and a second support pole attached to said canopy for supporting said canopy about said sleeping bag, wherein said plurality of support poles are each comprised of an inverted U-shaped structure, wherein said first support pole is adjacent said end panel, wherein said second support pole is centrally positioned within said canopy, and wherein said first support pole is substantially taller than said second support pole;

at least one mid-point support pole sleeve attached to an inner surface of said canopy for receiving said second support pole;
a mesh side window positioned within one of said pair of side panels;
a storage compartment attached to an end of said canopy opposite of said end panel; and
a plurality of storage ties to secure said sleeping bag, said ground cloth and said canopy in a rolled-up position.

These features are not disclosed, suggested or made obvious by the prior art cited in the Office Action. It is respectfully requested that independent Claim 18 is in condition for allowance along with its respective dependent claims.

D. CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited. Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, they are invited to telephone the undersigned.

Respectfully submitted,



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